

### III. REMARKS

1. Claims 1 and 12 are amended.

2. Claims 1-23 are not unpatentable over Kenner in view of DeLorme under 35 U.S.C. 103(a) because a *prima facie* case of obviousness cannot be established and the proposed combination does not disclose or suggest each feature recited by Applicant in the claims.

It is submitted that there is no motivation to combine Kenner with DeLorme to achieve the aspects recited in the claims, as is required for obviousness under 35 U.S.C. §103(a). In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142).

Neither reference provides the requisite suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of Kenner and DeLorme. Kenner is directed to a "video clip storage and retrieval system." (See e.g. Abstract). The system enables an efficient download of video clips to a user terminal. (Col. 7, lines 23-34). DeLorme relates to a computer aided map location system. (Abstract). The concept in DeLorme is for a system that correlates and coordinates spatially related data between digital electronic media. (Col. 1, lines 7-13). In DeLorme, the system makes it easier for the user to select a traveling route because the location of the user on the map can be determined on the basis of information shown on the display. However, the system of DeLorme requires that the user have a separate paper map or something similar. There is no teaching in DeLorme related to having a user define a criteria for information retrieval and that the

information is searched from a server on at least the basis of the current location of the user or the travel route of the user, or on the basis of both the current location and the travel route of the user, as is claimed by Applicant.

The claims recited by Applicant are directed to transmitting information to a mobile user, which includes sending an information query from a mobile search terminal, where the information query includes the current location or travel route of the mobile user. There is no motivation or suggestion to be found in either of the references that would cause one of skill of art to modify a video clip storage and retrieval system with a computer aided map location system, to achieve what is claimed by Applicant. Kenner deals with video clips. DeLorme deals with spatially related data (map data), and not video clips. There is no disclosure or teaching in the references relating the two.

Thus, it is submitted neither Kenner nor Delorme and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the references as proposed for purposes of 35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Kenner deals with video clips. DeLorme deals with spatially related data (map data), and not video clips. The Examiner states that it would be obvious to modify Kenner in view of DeLorme because "such a modification would allow Kenner to have spatially related information that can be queried from databases relevant to the selected grid quadrangle." However, it is submitted that there is no suggestion or purpose in Kenner to have spatially related information or querying information from "databases relevant to the selected grid quadrangle". In Kenner, the user merely requests a desired video clip. There is no teaching related to a grid quadrangle.

The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation to modify a video clip storage and retrieval system (Kenner) in view of a computer aided map location system that does not even mention video clips,

appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Kenner and DeLorme under 35 U.S.C. §103(a) is not established.

It is also submitted that Kenner and DeLorme have been combined improperly. References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In this case Kenner and DeLorme are not analogous art. A reference is analogous art if:

- a) The reference is in the same field of endeavor as the applicant's, or
- b) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Neither Kenner nor DeLorme is in the same field as the Applicants' invention. Kenner is directed to video clip storage and retrieval. DeLorme is a computer aided map location system. Applicant's claims are directed to transmitting information to a mobile user. These are not the same fields of endeavor.

Kenner and DeLorme are also not reasonably pertinent to the particular problem with which the Applicants were concerned. The Applicants were concerned with transmitting information to mobile users, which includes sending a query from a mobile search terminal where the query has the current location or travel route of the mobile user. A remote server is selected for the information search based on the current location or travel route. Kenner is not reasonably pertinent to that problem. The system in Kenner provides a user with comprehensive data collected from one or more databases by request from a user's multimedia terminal, where the data is in the form of video clips. (Col. 4, lines 36-42). DeLorme wants to correlate and coordinate spatially related data. Neither of these references relate to what is achieved by Applicant's claims. Thus, Kenner and DeLorme are not in the same field of endeavor as the Applicant and are not reasonably pertinent to the particular problem with which the Applicants were

concerned. Kenner and DeLorme are not analogous art and may not properly be combined for purposes of 35 U.S.C. §103(a).

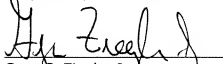
Additionally, the combination of Kenner and DeLorme does not disclose or suggest each feature claimed by Applicant. The combination of Kenner and DeLorme does not disclose or suggest sending, from a mobile terminal, an information query that includes at least the current location or travel route, for information to be retrieved. The combination of Kenner and DeLorme does not teach the selection of the remote server for the information search on the basis of the current location or travel route of the mobile user and the routing of an information query on the basis of the current location or the travel route of the mobile user. Col. 24, lines 52-53 of DeLorme mentions that location/object databases such as hotel/motel guides 53, restaurant guides, etc. are available on floppy diskettes selected by the user. The operation of DeLorme are performed in the computer, PDA or other similar device carried by the user, and all the information relating to the services near the location of the user are retrieved from the device of the user.

The combination of Kenner and DeLorme does not disclose or suggest using the current location and/or the travel route of the mobile user in the selection of the remote server and in routing the information query. Thus, it is submitted that claims 1-23 are not disclosed or suggested by Kenner in view of DeLorme.

For the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for the RCE fee (\$790) and a two-month extension of time fee (\$450), together with any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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23 August 2006

Date

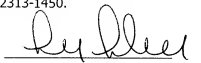
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